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09/827,630	04/06/2001	Eric J. Sprunk	18926003160	9042

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GENERAL INSTRUMENT CORPORATION
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EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,630

Applicant(s)

SPRUNK, ERIC J.

Examiner

Ponnoreay Pich

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application. *Cancelled*
- 4a) ~~Of the above claim(s) 15-19 is/are withdrawn from consideration.~~
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/2001, 2/2002, 4/2002, 4/02, 8/02, & 5/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-14 have been examined and are pending. Claims 15-19 were cancelled due to applicant's restriction election.

Priority

The examiner recognizes applicant's right to an earlier priority date due to application 09/827630 being a continuation in part of 09/580303, which in turn claims priority from provisional applications 60/0158491, 60/165094, and 60/174037. However, the oath and specification are defective which would have to be fixed before this right can be granted officially to the applicant. See below.

Information Disclosure Statement

The IDS submitted by the applicant have been considered.

Oath/Declaration

The oath makes no mention of priority claim to applications 09/580303, 60/0158491, 60/165094, and 60/174037. If applicant wants to be granted the rights to an earlier effective filing date, applicant must fix this defect in the oath or the effective filing date of the application will be the actual filing date of the application, which was 4/6/2001.

Response to Amendment

The examiner notes applicant's amendments to the specification which fixed minor errors and informalities. However, other informalities still exist in the specification. See below.

Specification

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In the specification, applicant cross-referenced to related application 09/580303. This was also noted in the application data sheet applicant submitted. However, no mention was made of provisional applications 60/0158491, 60/165094, and 60/174037 from which 09/580303 claims priority in either the cross-reference section of the specification or in the application data sheet. The examiner respectfully requests applicant cross-reference the above-mentioned provisional applications also (in both the specification and the application data sheet) if applicant wish to claim priority to 60/0158491, 60/165094, and 60/174037.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1:

Claim 1 recites a method for a securing plaintext object within a content receiver comprising steps with can be implemented using software alone. The plaintext object mentioned in the preamble, is disclosed on page 6, third paragraph of the specification as any collection of digital information. Digital information is not tangible and is just software. The term "content receiver" is mentioned in line 6, page 1 of the specification only and is not further defined. The examiner submits that because "content receiver" is not further defined, it

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reads on a software content receiver, i.e. an operating system. Nothing statutory is recited in claim 1.

The examiner notes that applicant can overcome this 101 issue by replacing "content receiver" with "set top box", which is defined as a hardware device in the specification or explicitly defining "content receiver" to be a hardware device, such as a set top box.

Claims 2-6:

Claims 2-6 are dependent on claim 1 and further defines the software method of claim 1, but still do not recite any statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7-9, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Epstein (US 6,865,675).

Claim 1:

Epstein discloses a method for securing plaintext object within a content receiver, the method comprising the steps of:

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1. Receiving a secure portion of a secure object (Fig 4 and col 6, lines 47-58).
2. Receiving a plaintext remainder of the secure object (Fig 4 and col 6, lines 47-58).
3. Determining which portion of the secure object is the secure portion (Fig 4 and col 6, lines 58-61).
4. Decrypting the secure portion to provide a plaintext portion (Fig 4 and col 6, lines 58-61).

Epstein further inherently discloses forming the plaintext object that comprises the plaintext portion and the plaintext remainder and storing the plaintext object (Fig 4). Note that on page 6 of applicant's specification, an object is defined as "any collection of digital information." The examiner submits that the decrypted ticket along with the content data disclosed by Epstein comprises the plaintext object, as together they are a collection of digital information and they are both in non-encrypted format. Further, a valid ticket is needed to enable access to the content data, so the ticket must always be located with the digital content (Fig 4). The examiner further submits that to display the content using the display device, the plaintext content must also be stored by the display device to some degree.

Claim 2:

Epstein further discloses:

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1. Selecting a secure portion of the plaintext object to encrypt (Fig 4 and col 12, lines 21-26).
2. Encrypting the secure portion (Fig 4 and col 12, lines 21-26).
3. Sending the secure portion and the plaintext remainder to a content receiver (Fig 4 and lines 24-26).
4. Providing a key that is used in decryption of the secure portion (Fig 4 and col 12, lines 4-7 and 26-30).

Claim 3:

Epstein inherently discloses reporting purchase of the plaintext object a point away from the content receiver (col 9, lines 16-21). Epstein discloses that the sink device (i.e. content receiver) makes a request to the source device to begin transmission of the protected content to the sink device (col 9, lines 16-21). The examiner submits that this reads on the limitation recited in claim 3 as the source device is a point away from the content receiver and the content receiver must provide proof of purchase or make a purchase at the source device before the source device would transmit the plaintext object. If the source device transmits the plaintext object (which includes a valid ticket) without first receiving proof of purchase, then there would be no point to the conditional access system disclosed by Epstein for controlling access to protected content.

Claim 5:

Epstein inherently discloses wherein the decrypting step comprises a step of decrypting the secure portion with an access control processor (col 9, lines 55-65).

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Claim 7:

Claim 7 is substantially similar to claim 2 and is rejected for the same reasons. The difference between the two claims lies in the preamble. Claim 2 recites a content receiver, while claim 7 recites a conditional access system. However, the examiner submits that a content receiver is inherently part of a conditional access system.

Claim 8:

Claim 8 is substantially similar to claim 1 and is rejected for the same reasons. The difference between the two claims lies in the preamble. Claim 1 recites a content receiver, while claim 8 recites a conditional access system. However, the examiner submits that a content receiver is inherently part of a conditional access system.

Claim 9:

Claim 9 is rejected for the same reasons as claim 3 as they are substantially similar.

Claim 11:

Epstein inherently discloses wherein removal of the secure portion from the plaintext object renders the plaintext object inoperable (Fig 4). The secure portion, i.e. encrypted ticket, is needed to enable access to the digital content (Fig 4). It is inherent that if the ticket was removed from the plaintext object that the plaintext object would be rendered inoperable.

Claim 12:

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Epstein further discloses a step of changing authorization of the content receiver from a point remote to the content receiver (Fig 4). Note the conditional access device sends the ticket which authorizes the receiver to access the content. The conditional access device is at a point remote from the receiver.

Claim 13:

The limitation recited in claim 13 is substantially similar to the one rejected in claim 3 and is rejected for the same reasons. The difference is that claim 3 recites reporting the purchase while claim 13 recites receiving the purchase information. Both language essentially amounts to the same thing, however, as the purchase information cannot be received unless it was reported.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein (US 6,865,675).

Claim 6:

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Epstein does not explicitly disclose the secure portion is less than one-half the size of the secure object. However, the secure portion is the encrypted ticket, which once decrypted is hashed to determine if it matches the watermark of the digital content (Fig 4). The ticket itself was originally derived from the watermark via a hash function (col 3, lines 26-27). The digital content can comprise any type of digital content including MPEG data (col 8, lines 29-44). By nature, a watermark is substantially smaller than the content it is encoded in, so this means that the watermark is less than one-half the size of the digital content. As the ticket is derived from the watermark, it is obvious that the secure portion (i.e. encrypt ticket) is less than one-half the size of the secure object, which comprises the encrypted ticket and the watermarked digital content.

Claim 10:

Epstein does not explicitly disclose wherein the reporting step is performed before the second listed sending step. However, the examiner submits that the choice of when to do the second listed sending step (whether it is before or after the reporting step) is an arbitrary choice as the receiver would not be able to use the digital content until the ticket is sent in Epstein's invention. Thus the limitation recited in claim 10 does not patentably differentiate from the spirit of the invention as disclosed by Epstein.

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Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein (US 6,865,675) in view of Wasilewski et al (US 6,157,719).

Claim 4:

Epstein does not explicitly disclose wherein the second listed receiving step is performed before the reporting step. However, Wasilewski discloses that at the time the applicant's invention was made, it was common to permit access to broadcast information only to those who paid for it, which was usually done via scrambling the content (col 1, line 65-col 2, line 5).

It is obvious from Wasilewski's teachings that it is common practice for the content to be continuously transmitted to the content receiver, but only once the content is purchased and the purchase was reported would the content receiver be allowed access to the content. In the case of Epstein's invention, it is obvious that enablement of the content data would be through the receipt of a valid ticket at the content receiver. Thus, it is obvious that the second listed receiving step would have commonly been performed before the reporting step. One of ordinary skill would have been motivated to incorporate Wasilewski's teachings because he teaches that what he disclosed was one of the common alternatives to making money by distributing information on a broadcast medium (col 1, lines 61-63).

Note that it would have been just as obvious to send the plaintext remainder before after the purchase was reported. The choice of when to do the sending is arbitrary as the receiver cannot use the content until a valid ticket is

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sent and a valid ticket would not be sent until a purchase is reported. Either choice would not differentiate from the spirit of Epstein's invention.

Claim 14:

Epstein does not disclose the key is a symmetric key. However, Wasilewski discloses a key being a symmetric key (col 6, lines 18-23). It would have been obvious to one of ordinary skill in the art at the time the application's invention was made to have incorporated Wasilewski's teachings with Epstein so that the key is a symmetric key. One of ordinary skill would have been motivated to incorporate Wasilewski's teachings as he discloses that his teachings would permit an easy way of permitting a customer to change entitlement agents as he or she sees fit (col 10, lines 50-51).

Double Patenting

Applicant is advised that should claim 2 be found allowable, claim 8 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. The same applies to claim 9 with respect to claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 8:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP



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